

RECEIVED
CENTRAL FAX CENTER

Appl. No.: 10/652,793
Amdt. Dated: 02/16/2010
Off. Act. Dated: 11/16/2009

FEB 16 2010

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein.

The Examiner has rejected all of the claims as being obvious based on *Wilshire* (U.S. No. 7,171,110) in combination with *Yap et al* (U.S. Pat. Doc. No. 2007/0127887). In support of the rejection, the Examiner stated that the only difference from *Wilshire* was that the "*means...was not described as removing the deleted content from the play list while deferring the release of the storage space pertaining thereto until the storage space is needed for the recording of additional content.*" The "means" to "recover content that was accidentally deleted," according to the Examiner, is provided by the *Yap* reference at paragraph 0173.

The Applicant respectfully disagrees, and submits that the *Yap* reference in combination with *Wilshire* does not render the invention as claimed in the amended claims. While *Yap* discloses an "undelete function," permanent deletion (i.e. overwrite) is based on time since deletion rather than on user preference settings, status or a user preference engine. Accordingly, the invention as claimed produces different results than would be produced by combination proposed by the Examiner.

When determining whether a claim is obvious, an Examiner must make "[a] searching comparison of the claimed invention—*including all its limitations*—with the teachings of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed.Cir.1995) (emphasis added). The Examiner must identify and compare the *characteristics* of the whole invention that is disclosed in the referenced patent and compare those elements with the language of the claims. The identification and characterization must also be technically accurate and not based on "possibilities." According to MPEP §2112, "The fact that a certain result or characteristic may occur or be present is the prior art is not sufficient to establish inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534."

Appl. No.: 10/652,793
Arndt. Dated: 02/16/2010
Off. Act. Dated: 11/16/2009

Accordingly, the prior art reference or combination of references must have the "functional" limitations recited in the claims and there must be some rational basis for making a combination to provide a function. The functions of "a tooth etchant" and "a hemostatic agent" are not found in the references and there is no teaching, suggestion or motivation to provide these functions found in the references or the art.

II. Rejection of Claims under 35 U.S.C. § 103(a)

A. Rejection of Claims 12-19 and 38-45 under 35 U.S.C. § 103(a) over Wilshire in view of Yap et al.

Claims 1, 9-15, 18-20, 27-28, 31-32 and 35 were rejected as being unpatentable under 35 U.S.C. § 103(a) over *Wilshire* (U.S. No. 7,171,110) in view of *Yap et al* (U.S. Pad. Doc. No. 2007/0127887).

In response, the Applicant has amended the claims to further define the invention with respect to the cited art. Figure 17 and paragraphs 0171 through 0173 of *Yap* describe a system that permits a user to delete a file and thereafter "undelete" that file from permanent deletion within a defined timeframe. Attempts to undelete outside of the timeframe will be impossible and ineffective. Time since deletion is the only variable that can be inferred in *Yap* if the space is not needed for recording additional content. If the space is needed, the deleted content will be overwritten regardless of time since deletion.

In contrast, the claimed invention "moves pointers" of the content from the play list to a replacement queue and the associated content indicators remain with the content. The deleted content is not written over or permanently deleted unless the content meets the preference settings or criteria or received from a preference engine. The content space is not available to be used for recording additional content unless certain criteria are met.

The amendments emphasize the functional differences. Accordingly, the Applicant respectfully requests that the rejection under 35 U.S.C. § 103(a) be

RECEIVED
CENTRAL FAX CENTER

Appl. No.: 10/652,793
Am dt. Dated: 02/16/2010
Off. Act. Dated: 11/16/2009

FEB 16 2010

withdrawn.

II. Amendments Made Without Prejudice or Estoppel.

Applicant has made these amendments in order to expedite allowance of the currently pending subject matter, without any prejudice, waiver, or estoppel, and without forfeiture, or dedication to the public, with respect to the original subject matter of the claims as originally filed. Applicant reserves the right to pursue the original scope of these claims in the future, such as through continuation practice, for example.

III. Conclusion.

In the event any further matters remain at issue with respect to the present application, Applicant respectfully requests that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Dated: 02/16/2010

Respectfully submitted,



John P. O'Banion, Reg. No. 33,201
Steven L. Smith, Reg. No. 44, 343
O'BANION & RITCHIEY LLP
400 Capitol Mall, Suite 1550
Sacramento, CA 95814
(916) 498-1010